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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,554	10/26/2000	Akihiro Yamada	SONY-U0362	4006

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EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/697,554	YAMADA, AKIHIRO	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DETAILED ACTION

1. Contrary to Applicant's assertion, the specific type of information storage unit and whether or not the game executing device is configured as a game controller without a storage means does not emphasize existing claim requirements. These limitations do not correspond to any existing limitation in the claims. Furthermore, they do not place the application in better form for appeal by reducing or simplifying the issues. They will not, therefore, be entered.

Response to Arguments

2. Applicant's arguments filed 14 June 2004 have been fully considered but they are not persuasive.

3. Applicant argues that the references fail to teach a set-top-box because Crawford teaches a computer. Yet a set-top-box is nothing more than a computer. It has a processor that runs programs – just like a computer. It has some input means and some output means – just like a computer. Applicant's set-top-box is associated with a cable television system. Crawford's set-top-box is associated with a cable television system. In short, Applicant's set-top-box has the same function and structure as the computer described in Crawford. Applicant cannot distinguish over the prior art by merely changing what the computer is called.

4. Applicant argues that Crawford fails to teach a digital communication line that is external to the set-top-box. As pointed out in the rejection, Crawford teaches such a communication line (134) in Fig 4. Crawford also clearly teaches a display device (54) and a game-executing device (52) that interconnects these devices to form a game machine system.

5. Applicant's assertion that it is clear error to assert that Crawford teaches a set-top-box is erroneous. Applicant admits that Crawford teaches a cable television connection (134).

Applicant seems to believe that there is a significant difference between cable television and satellite television. Examiner cannot agree. Cable television signals are equivalent (and indistinguishable from) satellite television signals. Furthermore, Crawford's Fig 4 clearly and unambiguously shows that the signals may be satellite signals. They may come form satellite (126). Therefore, even if there were a difference between the types of television signals (which Examiner does not believe), Crawford teaches the exact type of signal that Applicant claims – satellite television signals.

The fact that the signals may be cable television signals has no bearing on patentability for at least three reasons. First, because the existence of alternative embodiments do not change the fact that satellite signals are taught by the reference. Second, because (as noted above), satellite television signals are equivalent to cable signals. And third because, as a factual matter, cable televisions signals ***are*** satellite television signals – satellites are used to deliver the signals to the cable companies.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7. Applicant argues that Schlindler supports his contention that Crawford fails to teach a set-top-box because Schlindler teaches a set-top-box that contains an integrated receiver/decoder. There are at least two problems with this argument.

a. First, the argument is not commensurate with the scope of the claims. Applicant's claims do not contain language requiring the set-top-box to include such a decoder. Examiner cannot read limitations into the claim.

b. Second, Crawford teaches a system (50(Z)) that does connect to the cable television system. Applicant admits that this connection supplies television signals to 50(Z). Therefore, the system must have a decoder for processing the television signals. Examiner believes that decoder to be a part of 50(Z), but even if it is not, Schindler clearly teaches a device with an integral decoder. Thus, even if Crawford were deficient in this respect (and Examiner submits that Crawford is not), Schindler renders the (unclaimed) structure obvious.

8. Applicant argues that Crawford fails to teach a digital communications line that is external to each of the STB, display device, and game-executing device that interconnects these devices to form a game machine system. Further, Applicant argues that communication line (150) fails to connect the monitor, mouse, keyboard, etc. to form a game system. Applicant misunderstands the rejection. Figs 1 & 3 show the hardware configuration of the system. The cable for the mouse, keyboard, monitor, and digital communication line (150) all connect to the computer's bus. They are al digital communications lines. They connect the component parts into a single game machine system. And, because they are all interconnected, they form a digital communication line.

9. Applicant argues that Crawford's teaching that prior systems have been used to download computer games does not mean that Crawford is used to do so. Applicant suggests that because Crawford describes the function as prior art that means that Crawford cannot be cited as teaching

the function. This is not a persuasive argument. This would be the equivalent of saying that Crawford "unteaches" something that it describes as well known in the art. This clearly cannot be the case. Crawford is unambiguous that one of the major uses to which the type of system described has been put is the delivery of game software. Furthermore, software is nothing more than a bit-stream. The computer cannot tell what the program is. It may be a card game or it may be a spreadsheet – to the computer, it makes no difference. Games and spreadsheets are equivalent. It happens, however, that Crawford teaches that information service providers (like that described by Crawford) often download games as part of their business. This certainly provides the suggestion and motivation to allow games to be downloaded.

10. Applicant argues that combining Crawford and Schindler would destroy the flexibility of Crawford. This is not the case. Crawford teaches a system that receives and processes television signals (i.e., Electronic Media Services and multi-media service). Crawford does not specifically state that these television signals are television program signals. Schindler merely teaches that it is well known to have the STB process television program signals. Adding Schindler does not take away from the flexibility of Crawford. Crawford already processes television signals. Schindler merely indicates that these television signals may correspond to television programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (703) 308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER